

REMARKS/ARGUMENTS

These Remarks are in reply to the Final Office Action mailed February 23, 2005.

Claims 1-27, 33-35, 47 and 48 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-27, 33-35, 47 and 48. The present Reply demonstrates the patentability of claims 1-27, 33-35, 47 and 48, as amended, leaving for the Examiner's consideration claims 1-27, 33-35, 47 and 48.

I. Summary of Office Action

Claims 1-3, 5-10 and 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado (U.S. Patent No. 6,542,165; hereafter, "*Ohkado*"). Claims 22-25, 27, and 48 were rejected for similar reasons without any substantive analysis beyond that given for claims 1-3, 5-10 and 15-20.

Claims 4 and 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado in view of England (U.S. Patent No. 6,144,991; hereafter, "*England*").

Claims 26 and 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado in view of Gutfreund et al. (U.S. Patent No. 6,192,394; hereafter, "*Gutfreund*").

Claims 21 and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado in view of Varma et al. (U.S. Patent No. 6,564,246; hereafter, "*Varma*").

II. Amendment to Claims

Although no objection was raised to claim 47 on grounds of indefiniteness under 35 U.S.C. § 112, Applicants have amended claim 47 to correct the reference in the last element to refer to "and to one of highlight, grey, and make invisible" instead of "and one of highlight, grey, and make invisible," thereby making the claim more fully consistent with the specification, and promoting greater definiteness.

III. Response to Rejections

As a preliminary matter, the Final Office Action refers, in the next to last paragraph on page 2, to sections of Ohkado that, it is suggested, disclose an application configured to access the artifact, wherein the application is associated with the file type. The final citation is "col. 12," which

presumably, considering subsequent discussions, is intended to refer to column 12, lines 45-50. If Applicants are mistaken in this assumption, they respectfully request that the Examiner kindly inform us immediately, using the contact information for our authorized legal representatives.

The present invention discloses a system whereby users are able to engage in conversations anchored to locations within commonly viewed files. These files are viewed from their native applications on the system of each user. The claimed system is especially efficient as it utilizes the file viewing capacities of applications associated with the file. For example, a Microsoft Excel document could be viewed from the Microsoft Excel application on the user's system.

Ohkado, which discloses a system of collaborative image generation programs, does not disclose or suggest the features of the claimed invention. *Ohkado* does not disclose the collective accessing and conversing about files. The annotations or windows anchored in context within a document, as disclosed by *Ohkado*, cannot be equated with a conversation. Rather *Ohkado* discloses a system for highlighting physical sections of a viewing window so that the sections can be viewed on other systems. User's ability to update annotations can in no manner be equated with a conversation such as the anchored conversations disclosed by Applicants. A conversation is, for purposes of Applicants' disclosures, an ongoing, multi-directional, sequential exchange of streaming messages. Moreover, according to Applicant's disclosures and in marked contrast with *Ohkado*, past messages are saved in a persistent manner providing a history of the conversation. By contrast, *Ohkado* discloses annotations that are single images that can be modified in final form only, are not streaming, and do not provide a history of the markings. Therefore, the current disclosures differ from *Ohkado* in communication technique, implementation, and user experience.

Specifically, contrary to the suggestion of the Final Office Action, and unlike Applicants' claim 1, *Ohkado* does not disclose an application configured to access the artifact, wherein the application is *associated with the file type*. The first cited excerpt from *Ohkado* (fig. 1) discloses a block diagram showing a hardware configuration suitable for operation of the invention, consisting of a system, apparatus, and method of relating annotation data to an application window. The second cited excerpt from *Ohkado* (fig. 2) discloses a block diagram of components suitable for operation of the invention, consisting of a system, apparatus, and method of relating annotation data to an application window. The third cited excerpt from *Ohkado* (fig. 3) discloses a diagram showing an example of a user interface in the preferred embodiment of the invention, consisting of a system,

apparatus, and method of relating annotation data to an application window. The fourth cited excerpt from *Ohkado* (col. 9, line 16) discloses that the subject application is an application which is a subject of annotation.

The fifth and final cited excerpt from *Ohkado* (col. 12, lines 45-50, per the assumption made in the first paragraph of this section of our reply) discloses that, after a session with the other computer is established, and after a desired application is selected from the list of applications, "the kind of application, the file name used or to be used... and the window size... are obtained in the main station side and transmitted to the other computer system." This disclosure therefore relates to selection an application type, file *name*, and window size to be used by the remotely located terminal displaying a corresponding transparent window. Therefore no disclosure whatsoever appears regarding an application that is *itself* configured to access an artifact, said application being *itself* associated with the file type. Despite the Final Office Action's attempted conflation of file *name* and file *type* in its reference (p. 10, para. 7) to "file name/type," it is well known that the two concepts are quite distinct and can in no way be equated with each other. The application of *Ohkado* does not perform any of the recited features (annotation, etc.)

Similarly, the annotations of *Ohkado* are not associated with the files themselves, but rather the raw images that are transmitted, as indicated in col 3 ln. 20-24 "a step of sending image data of said application window". The Final Office Action's suggestion that *Ohkado* (col. 12, lines 45-50) discloses these elements is not supported by the cited disclosures. Specifically, the Final Office Action notes that *Ohkado* (col. 12, lines 45-50) "discloses that the application and file to be used in collaboration is selected prior to establishing the collaboration session." However, these disclosures do not at all suggest or teach annotations that are associated with the files themselves.

Similarly, *Ohkado* does not disclose an artifact comprising a file having a file type. The artifacts of *Ohkado* are raw image data, rather than files associated with particular applications. The approach of *Ohkado* is distinctly inferior as the disclosed text communications are not associated with artifacts documents, but rather raw images highlighted within a user's desktop. Furthermore, *Ohkado* depends on the capacity of the receiving client to receive raw image files.

Claim 3, in addition to the limitations of claim 1, additionally recites that the conversation element is configured to allow access to sections of the artifact outside the anchor. *Ohkado* is manifestly deficient of this feature. The section of *Ohkado* cited by the Examiner (col. 12-13; no line

numbers provided) discloses the drawing of an annotation in the transparent window, and the collaboration with another terminal located in a remote location, not accessing sections of the file outside the shared space. Indeed the system of *Ohkado* cannot allow access to sections of the application outside the anchor, and teaches away from a system that does allow access to such sections of the application, because the system of *Ohkado*, rather than utilizing a shared chat space that is anchored to a section of a file, transmits raw graphical information to the other clients.

Claim 5 recites the creation of a recipient conversation having an anchor, application, and artifact that are equivalent to the artifact, anchor, and application the requesting conversation client. *Ohkado* fails to disclose or suggest this feature. Claim 1 recites that the artifact is a file having a file type. Thus claim 5, when taken with the limitations of claim 1, recites that the recipient conversation includes an artifact that is a file having a file type, equivalent to the one on the initiating conversation client.

However, the remote parties discussed in *Ohkado* *cannot* view an original or copy of the remote source file, as the system of *Ohkado* only transmits raw images from sections of the source file. As discussed in the cited section "a second display apparatus for displaying image data of said first application window". Thus, it is impossible for a conversation recipient in *Ohkado* to have an artifact equivalent to the artifact of the requesting conversation client, as the system of *Ohkado* does not provide access to files, only to raw image data extracted from the file.

Regarding independent claim 48, the Final Office Action comments (page 6, last paragraph) that this claim does not teach or define any new limitations above claims 1-3, 5-10, 15-20 and therefore is rejected for similar reasons. Accordingly, we incorporate by reference our above arguments for the patentability of claim 1, and argue for similar reasons that claim 48 is also patentable. Additionally, we note that contrary to the suggestion of the Final Office Action, independent claim 48, in addition to the patentable subject matter of the other independent claims, recites that communications are received by parties having access to the file. *Ohkado* is deficient of any mention of this feature and as discussed above, such functionality is incompatible with the system of *Ohkado*, as remote parties are only given access to image slices extracted from the application. For all these reasons, independent claim 48 is patentable.

Claims 4 and 11-14, 26 and 33-35, were rejected over *Ohkado* in view of *England*, *Gutfreund*, and *Varma* respectively. With respect to these rejections, including the rejection of

independent claim 33, the Final Office Action cites no motivation to combine the references. The Final Office Action provides a *benefit* for combining the references, but demonstrates no motivation, either explicit or implicit, in any of these references for combining them. The law is clear that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The Federal Circuit has held, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification*..... it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992).

Applicants disclose an inventive method for integrating a large number of components, and further disclose adjustments required of the components to provide the overall capability for the in-context, streaming communications of anchored conversations. These disclosures are not obvious and are patentable.

Regarding amended independent claim 47, the Final Office Action comments (page 10, 4th paragraph) that this claim does not teach or define any new limitations above claims 1-27, 33-35 and therefore is rejected for similar reasons. Accordingly, we incorporate by reference our above arguments for the patentability of claims 1-27 and 33-35, and argue for similar reasons that claim 48 is also patentable.

The references cited in the Office Action, including *Marsland*, and *Clark*, considered singly or in combination, fail to disclose all of the limitations of independent claims 1, 33, 47, and 48, as amended. Claims 2-27 and 34-35 each ultimately depend from one of the independent claims and are believed patentable for at least the same reasons as the independent claims and because of the additional limitations of these claims.

Accordingly, claims 1-27, 33-35, 47 and 48, as amended, are believed patentable over the cited references and withdrawal of the rejections is respectfully requested.

CONCLUSION

The references cited by the Examiner, but not relied upon, have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date:

6/23/05

By:

J. Steven Svoboda
J. Steven Svoboda
Reg. No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Fax: (415) 362-2928
Customer No.: 23910